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G.P. 1615

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue

Application Serial No: 09/014,518 Group Art Unit: 1615

Applicant: Roderick Thompson Examiner:

Filed: January 28, 1998

For: U.S. Patent 5,472,790

CERTIFICATE OF EXPRESS MAILING

Assistant Commissioner for Patents
Washington, D. C. 20231

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JUN 15 1998

Sir:

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GROUP 150

I hereby certify that the accompanying Protest along with any items referred to as being attached or enclosed, is being deposited with the United States Postal Service, Express Mail Customer Receipt No. EL095470280US on May 26, 1998.

Date: May 26, 1998

By: John R. Benefiel
John R. Benefiel
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280 Daines Street
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CERTIFICATE OF SERVICE

The signature below certifies that a copy of this Protest and all accompanying papers has been served on the patent owner by depositing the documents in an envelope bearing first class postage in an official U.S. Postal Service depository, on the date set forth below, addressed as follows:

Neil F. Martin
Brown, Martin, Haller & McClain
1660 Union Street
San Diego, CA 92101

Date: May 26, 1998


John R. Benefiel

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reissue

Application Serial No: 09/014,518

Group Art Unit: 1615

Applicant:

Roderick Thompson Examiner:

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U.S. Patent 5,472,790

PROTEST

United States Department of Commerce
Patent and Trademark Office
Assistant Secretary and Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

Protestor Progressive International Corporation of Kent, Washington hereby protests the allowance of the above-identified reissue application.

This Protest is based on the prior art previously submitted in the Reexamination Application 90/004,752, which proceeding is now merged with the reissue application examination pursuant to the Decision to Merge dated April 23, 1998, as well as the evidence of prior offer and sale submitted with the accompanying petition under 37 CFR § 1.292, and the following grounds:

1. There was a prior invention of a flexible polypropylene sheet cutting pad by a Mirian E. Gillett under 35 USC § 102(g) which anticipates and/or renders obvious the methods set forth in the reissue application claims.

2. Roderick Thompson, the alleged inventor of the reissue application, derived the alleged invention from Mrs. Gillett and is precluded from patenting the claimed invention under 35 USC § 102(f) and the prior invention should be part of the prior art considered under 35 USC §103.

3. The method claims are unpatentable over the Rosmat and Counter-Maid publications. Roderick Thompson did not himself

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Applicant has been notified JTG

discover the parameters set forth in the claims, and, hence under 35 USC § 102(f) these parameter recitations cannot be relied on to distinguish over the prior art considered under 35 USC § 103.

4. The method claims are indefinite under 35 USC § 112.

5. At least some of the claims are broader than the original patent claims and hence are improper as submitted more than two years after issuance of the original patent.

6. Applicant has consistently failed to make complete disclosures to the Patent and Trademark office as required under the current standards of candor as set forth in Rule 56.

7. The District Court opinion is erroneous and not binding on the Patent and Trademark Office.

DISCUSSION

1. The Method Claims Are Unpatentable Under 35 USC §102(g)

Mrs. Gillett's Counter-Maid mat is prior art under 35 USC § 102(g). The abandoned patent application of Mrs. Marian Gillett (Baker Declaration) and the documents and statements of the Fishman and Stoneman Declarations and mat samples clearly establish prior invention under 35 USC §102(g) which anticipates and makes obvious the invention claimed in Claims 1-11 of the reissue application.

The abandoned application, while not a prior publication, is "competent and cogent evidence" as to the nature of a prior invention by another Smith v. Hall, 301 U.S. 216, 33 USPQ 249 (1937).

As stated in Smith the lack of widespread commercial success of the earlier invention does not disqualify the invention under 35 USC § 102(g), since such lack of success can be for reasons other than the commercial advantages of the prior invention.

The abandoned application describes a thin flexible sheet (approximately 9 mil thick) of polypropylene plastic used as a cutting surface and which can be used to transfer the cut food into

a vessel. Mr. Thompson testified in his deposition (page 80 of Exhibit 1 previously submitted by Petitioner in the Reexamination) that Mrs. Gillett sought his help in marketing it -- thus at the time of his alleged "invention", she clearly had not abandoned, suppressed or concealed her invention. As is clear from the Fishman Declaration, the Counter-Maid mat had previously been constructed and sold to the public. Thus, Mrs. Gillett's Counter-Maid mat, as described in the patent application, is prior art under 35 USC § 102(g). The other disclosure documents and the Stoneman and Fishman exhibits show that a material thicker than 9 mils was also contemplated.

As established by his own deposition testimony, Mr. Thompson did not himself select the material parameters as to the particular type of plastic, its Rockwell hardness, or flexural modulus, nor are the specific range values demonstrated to be critical such as to be unobvious. Thus, the particular hardness and flexural modulus values cannot be relied on to establish patentability. Further, as developed at length in the Reexamination, the Rockwell hardness and flexural modulus value ranges are simply typical ranges for polypropylene and thus would have been obvious under 35 USC § 103 in any event.

Furthermore, the evidence shows that the Counter-Maid mat is constructed of copolymer polypropylene and most likely Hercules Resin 7623. This material has a Rockwell hardness of 86 and flexural modulus of 210,000 psi, according to the 1981 International Plastics Selector substantially the same values as claimed. In any event, these values are typical of copolymer polypropylene and cannot establish patentability of the reissue application claims as criticality has not been shown.

2. Roderick Thompson Derived The Invention From Mrs. Gillett And Cannot Patent The Same Invention Under 35 USC § 102(f)

Mr. Thompson admitted in his deposition that he had obtained a Counter-Maid sample and had the sample tested to attempt to determine what it was. It is curious that he made his mat of the exact same material (copolymer polypropylene) and only slightly thicker (10 mil instead of 9 mil). The specific recited parameters of the material he admittedly did not originate as described above.

The original Schneider Plastic packaging attached to the Benefiel Declaration shows a close similarity to the Counter-Maid flyer.

Applicant recently obtained samples of the Counter-Maid mat, and has grudgingly admitted in its Supplemental Information Disclosure Statement that the Counter-Maid mat lies flat and will support 5 ounces and is at least 8 mils in thickness. Applicant has not disputed the laboratory tests and other evidence indication the mat is made of copolymer polypropylene.

It seems clear that the Chop Chop mat was a close copy of the Counter Maid mat, and that Mr. Thompson in effect has patented this same mat, dressed up with technical jargon supplied by his patent attorney. In this reissue application, Applicant persists in this improper enterprise despite the overwhelming evidence of the existence of these facts.

It is noted that the CAFC has held that prior art under 35 USC § 102(f) or (g) can be combined with other prior art to find unpatentability under 35 USC §103, ODDZ on Products v. Just Toys Inc., 43 USPQ 2d 1641 (1997).

3. The Method Claims Now Presented Are All Anticipated Or Obvious In View Of The Rosmat Or Counter-Maid Publications

Both the previously cited Rosmat and Counter-Maid publications suggest or describe explicitly the methods recited in the claims, i.e., using a flexible plastic sheet, as a food cutting mat, and transferring the cut food by bending the sheet to form a funnel to enable deposits of the food into a container. The Rosmat articles explicitly describe the use of polypropylene as a durable food safe material able to resist knife cuts to be suitable for use as a flexible cutting mat.

The use of copolymer polypropylene for the mat was not conceived by Mr. Thompson, and would be obvious in any event as it was well-known for food contact uses. There is no described unexpected result from using copolymer as contrasted with homopolymer polypropylene. The specific values of Rockwell hardness and flexural modulus are typical for polypropylene and no criticality has been shown or even argued.

4. The Application Claims Are Indefinite

Claims 1-9 all contain a reference to a Rockwell hardness. However, no Rockwell scale is given with the number recited, nor is the scale given in the specification. Rockwell numbers are normally specified as on a given scale, such as B, C, M, R. In the absence of a scale designation, the claims are indefinite.

Claims 2 and 9 recite "amorphous copolymer polypropylene". However, polypropylene is normally considered semicrystalline, not amorphous. "Amorphous" means noncrystalline, i.e., "atactic". See the attached articles Modern Plastics, Mid-November 1994 and Branson Technical Information, PW-1, 4/93. Atactic polypropylene has no structural strength and could not be employed for use as a cutting mat. These claims thus define an inoperative structure, or incorrectly specify amorphous or atactic polypropylene when

"isotactic" or semicrystalline polypropylene could possibly be used.

Claims 10 and 11 improperly recite structural characteristic as a "means". A hardness characteristic and a flexibility characteristic are not functions as could properly be phrased in a means plus a function format. Thus claims 1-11 are indefinite under 35 USC § 112.

5. At Least Some Of The Claims Are Broadening And Thus Are Improper

Claims 10 and 11 are broader than the original claims as no hardness or flexural modulus values are recited, only broadly worded "means" claims. Thus, these claims could conceivably cover use of a sheet or method not incorporating the specific hardness or flexural modulus values originally claimed. As such, these claims are broadening, and not allowable, as the reissue application was filed more than two years after the original patent was granted.

6. The Applicant Has Consistently Failed To Fulfill The Duty Of Candor

The Applicant and his attorneys have knowingly or with gross negligence, consistently obfuscated the nature of the Counter-Maid prior invention and the circumstances of the inventor's knowledge and involvement with this prior art. Furthermore, it was first suggested by the Applicant that the plastic sheet material was novel when it was known to him that it was not, since there was an undisclosed sale of the material to the inventor himself more than one year prior to the filing of the first application. Despite having possessed a sample of the Counter-Maid mat, a grossly different description was given the Patent and Trademark Office. The parameters concerning the Rockwell hardness and flexural modulus values was not discovered by the inventor but was put forth in the claims of his invention.

Mr. Thompson did not disclose that he obtained the concept from Mrs. Gillett, and that the Counter-Maid mat was prior art under 35 USC §102(f) and (g). Mr. Thompson in effect has attempted to patent the invention of Mrs. Gillett by misrepresenting the nature of the her invention and of his own contribution. This violates the duty of candor due the Patent and Trademark Office and the reissue application should be denied on those grounds alone.

It is also noted that the file documents (Baker Declaration) indicate that Mr. Martin had substantively examined Mrs. Gillett's application.

Thus, both Mr. Thompson and his attorneys were fully aware of the details of the prior invention of the Counter-Maid mat by Mrs. Gillett.

7. The District Court Opinion

Applicant has cited the opinion of Judge Napoleon Jones in the pending litigation in the Southern District of California, construing the original patent claims as limited to use as a cutting and transfer mat, and to a specific size 11" x 15". This decision is not binding on the Patent and Trademark Office, see MPEP 2286, Ethicon v. Quigg, 7 USPQ 2d 1152, 1175 (CAFC 1988). Protestor has previously cited cases and arguments that the original patent claims were not limited to use of the recited sheet structure as a cutting and transfer mat, in particular In re Schreiber, 44 USPQ 2d 1429 (CAFC 1997). Applicant, in effect, has admitted this by filing the patent reissue.

Adopting the argument urged on the Court by the Present Applicant, the District Court has ruled that the claims implicitly are limited to sheets of 11" x 15" since this is the size of the example given in the patent specification. This limitation should not be implied into the reissue application Claims 1-11, as there is no legal basis for implying this specific limitation into the

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claims from the specification. See Sjoland v. Musland, 6 USPQ 2d 2020 (CAFC 1988), and Raytheon Co. v. Roper Corp., 220 USPQ 592 (CAFC 1983).

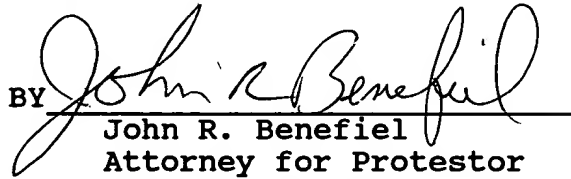
By Applicant's own statements in the patent file history, previously cited in the Reexamination, the sheets may be much larger than 11" x 15" and still be usable as a cutting and transfer sheet.

For these reasons, all of the reissue application claims should be rejected and the application denied.

Respectfully submitted,

Date: May 26, 1998

BY


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